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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,452	07/24/2003	Yelena Zolotarsky		1840

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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT PAPER NUMBER

1618

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/626,452	<b>Applicant(s)</b> ZOLOTARSKY ET AL.	
	<b>Examiner</b> James W. Rogers	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July, 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 4 is objected to because of the following informalities: the selection among the optional ingredients has the following error "oils, natural or synthetic," while natural or synthetic is referring probably to the oil it is not clear, the examiner recommends rewriting the claim to show the oil can be synthetic or natural an example being "a natural or synthetic oil," appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Halloran et al. (US 2003/0086954 received benefit of provisional application date).

O'Halloran teaches compositions for forming a peelable cosmetic film on the subject comprising polyvinyl alcohol, a thickener (including mixtures comprising polyacrylamide), emulsifiers and water all within the specified ranges listed by the applicants. The language of claim 1 does not preclude the extra ingredients used in the O'Halloran patent such as pullulan (which is a polysaccharide and could be considered a thickener in its own right). See abstract, [0002] lin 1-14, [0011] lin 1-12, [0020] lin 1-14, [0027] lin 1-5, claim 10 and 18. Regarding claim 4, O'Halloran teaches the use of active agents (including esters), and pigments. See [0009] lin 1-6 and [0012] line 1-3.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Edens et al. (US 6,368,595).

Edens teaches a topical application of enzymes (enzymes are known cosmetics) using a peelable film (can be comprised of PVA) using an evaporative solvent (water), and a thickener, also disclosed was the pH of the solution, all of the above are within the ranges specified by the applicants. See col 1 lin 1-2, lin 40-43, col 4 lin 8-9, lin 65-66, col 5 lin 15-18, 26-30, 41-42 and example 1. Regarding claims 6-7 the Edens patent disclosed several measurements of viscosity within the ranges specified by the applicant. See table 3.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edens et al. (US 6,368,595) in view of O'Halloran et al. (US 2003/0086954 received benefit of provisional application date).

Edens teaches as above.

Edens does not teach the specific thickeners sodium polyacrylate or polyacrylamide.

O'Halloran teaches as above.

It would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to combine the art described in the documents above because Edens teaches a topical application of enzymes (enzymes are known cosmetics) using a peelable film (can be comprised of PVA) using an evaporative solvent (water) and a thickener but does not teach the use of the specific thickeners sodium polyacrylate or polyacrylamide, while O'Halloran teaches compositions for forming a peelable cosmetic film on the subject comprising PVA, a thickener (including

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mixtures comprising polyacrylamide), emulsifiers and water. The motivation to combine the above two documents would be a peelable PVA film for application to the skin further comprising water and a thickening agent comprised of polyacrylamide.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edens et al. (US 6,368,595) in view of Zhang et al. (US 2003/0077377).

Edens teaches as above.

Edens does not teach the specific thickeners sodium polyacrylate or polyacrylamide.

Zhang teaches a peelable foam coating composition comprising solvent (aqueous) polymeric coating and thickening agents (can be sodium polyacrylic polymer) within the range specified by the applicants. See [0044] and [0046] in their entirety.

It would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to combine the art described in the documents above because Edens teaches topical application of enzymes (enzymes are known cosmetics) using a peelable film (can be comprised of PVA) using an evaporative solvent (water) and a thickener but does not teach the use of the specific thickeners sodium polyacrylate or polyacrylamide while Zhang teaches a peelable foam coating composition comprising solvent (aqueous) polymeric coating and thickening agents (can be a sodium polyacrylic polymer) within the specified range specified by the applicants. The motivation to combine the above two documents would be a peelable PVA film for

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application to the skin further comprising water and a thickening agent comprised of polyacrylamide.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,6-13,15-18 of U.S. Application No. 10/256,264. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1-5 and 8 are generic to all that is recited in claims 1,6-13,15-18 of U.S. Application No. 10/256,264. Specifically the emulsion composition of PVA in claims 1-5 and 8 is the same as claims 1,6-13,15-18 of U.S. Application No. 10/256,264. The language of claim 1 does not preclude the extra

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ingredients used in the O'Halloran patent such as pullulan (which is a polysaccharide and could be considered a thickener in its own right).

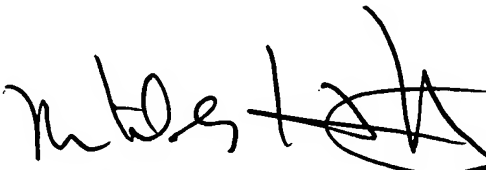
***Conclusion***

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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